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Response dated: December 27, 2006  
Appln. No. 10/658,449; Filed: September 9, 2003  
Response to Office Action of August 28, 2006

**REMARKS**

Claims 1-27 are currently pending. Claims 21 and 23 have been canceled. As a result of a previous restriction requirement, claims 25-27 have been withdrawn, leaving claims 1-20, 22 and 24 for prosecution in this application.

**Rejection of Claim 29 Under § 112**

The Examiner rejected claim 29 under 35 U.S.C. § 112, second paragraph, as being indefinite and suggested rewording the claim in the form of a Markush group. There is no claim 29 in this case, however.

**Rejection of Claims 21 and 23 Under § 101**

The Examiner rejected claims 21 and 23 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 21 and 23 have been canceled without prejudice.

**Rejection of Claims 1, 2, 4-6, 8, 9, 11-17 and 19 Over Zang, Wall, Homsy or Morgan**

The Examiner rejected claims 1, 2, 4-6, 8, 9, 11-17 and 19 under 35 U.S.C. § 102(b) over any of Zang US 5,314,486 ("Zang"), Wall US 4,693,722 ("Wall"), Homsy US 4,778,472 ("Homsy") or Morgan US 4,917,701 ("Morgan"). The Examiner contends that the prostheses disclosed by each of these references (1) "is structurally similar to that illustrated by applicant" and (2) "is capable of performing the function of replacing all or a portion of the natural facet joint." (Office Action at pp. 4-5) The Examiner's first point, however, misstates the requirements for anticipation. The question of anticipation under § 102 is not whether the reference discloses a device that is "structurally similar" to the device illustrated in Applicant's figures but is rather whether the reference discloses each and every feature recited by the claims. The Examiner's analysis does not even address the elements of claim 1.

The Examiner's second point is even more remarkable. Wall, Homsy and Morgan disclose temporomandibular joint prostheses. Zang discloses a metatarso-phalangeal joint prosthesis. The Examiner was not able to point to any disclosure in any of these references to

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support his contention that each of these prostheses could be implanted into a patient's spine to perform the function of replacing all or a portion of a natural facet joint.

Claim 1 recites a prosthesis with a prosthesis body accommodating fixation to a vertebral body at or near a pedicle and without support by a lamina and an artificial facet joint structure carried by the prosthesis body at a location spaced from the fastening element, the artificial facet joint structure being adapted and configured to replace all or a portion of a natural facet joint. The Examiner's action does not explain how any of these references discloses these elements. In fact, none of these references discloses every element of claim 1. Claim 1, and claims 2-20 and 24 depending from it, are therefore patentable over each of these references under § 102(b).

The Examiner did not specifically list claims 3, 7, 10, 20, 22 and 24 in his list of claims rejected under § 102(b), but the Examiner's ensuing remarks mentioned each of these claims. Applicant respectfully requests the Examiner to positively include or exclude these claims from his § 102 rejection in order to clarify the record in this case.

With respect to claims 11-18, 22 and 24, the Examiner's remarks appear to be limited to Zang and not at all to Wall, Homsy or Morgan. Applicant respectfully requests the Examiner to clarify the basis of his rejection of these claims in the next action so that the record will be unambiguous in any appeal.

#### **Rejection of Claims 11, 12, 14 and 18 Over Zang and Johnson**

The Examiner rejected claims 11, 12, 14 and 18 under 35 U.S.C. § 103(a) over Zang in view of Johnson US 5,609,641 ("Johnson"). (The Examiner's action actually reads "Claims 11-12, 14\*18." Applicant is assuming that the Examiner intended the asterisk to be a comma. Applicant respectfully requests the Examiner to clarify this aspect of his rejection so that the record will be clearer in any appeal.)

As discussed above, the Examiner never did apply Zang or any other reference specifically to claim 1. Nonetheless, Johnson fails to cure the deficiencies of Zang with respect to the elements of claim 1, from which each of these claims depends. Claim 1 recites a prosthesis with a prosthesis body accommodating fixation to a vertebral body at or near a pedicle and without support by a lamina and an artificial facet joint structure carried by the prosthesis body at a location spaced from the fastening element, the artificial facet joint structure being

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adapted and configured to replace all or a portion of a natural facet joint. Neither Zang nor Johnson, alone or in combination, discloses any of these elements. For at least these reasons, the Examiner's rejection of claims 11, 12, 14, and 18 under § 103(a) over Zang and Johnson is improper and should be withdrawn.

#### Rejection of Claims 12 and 13 Over Zang and Carignan

The Examiner rejected claims 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Zang as applied to claim 1 and further in view of Carignan US 4,955,916 ("Carignan"). As discussed above, the Examiner never did apply Zang or any other reference specifically to claim 1. Nonetheless, Carignan fails to cure the deficiencies of Zang with respect to the elements of claim 1, from which each of these claims depends. Claim 1 recites a prosthesis with a prosthesis body accommodating fixation to a vertebral body at or near a pedicle and without support by a lamina and an artificial facet joint structure carried by the prosthesis body at a location spaced from the fastening element, the artificial facet joint structure being adapted and configured to replace all or a portion of a natural facet joint. Neither Zang nor Carignan, alone or in combination, discloses any of these elements. For at least these reasons, the Examiner's rejection of claims 12 and 13 under § 103(a) over Zang and Carignan is improper and should be withdrawn.

#### CONCLUSION

For the foregoing reasons, Applicant requests the Examiner allow claims 1-20, 22 and 24 and advance the application to issuance.

Respectfully submitted,

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